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**UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF CALIFORNIA**

GEN-PROBE, INCORPORATED,  
  
vs.  
  
VYSIS, INC.,  
  
Plaintiff,  
  
Defendant.

CASE NO. 99-CV-2668 H (AJB)  
  
**Order Denying Motion for Stay and  
for Dismissal of Fourth Cause of  
Action**

On January 25, 2000, the plaintiff, Gen-Probe Incorporated ("Gen-Probe") filed a first amended complaint for declaratory relief and unfair competition relating to a patent and license agreement with the defendant Vysis, Incorporated ("Vysis"). On March 9, 2000, Vysis filed a motion to stay proceedings and for dismissal of the cause of action for unfair competition. Gen-Probe filed their opposition on April 10, 2000, and Vysis filed their reply on April 17, 2000. The motion was submitted on the papers and no oral argument was held.

**BACKGROUND**

Gen-Probe is a biotechnology firm which develops and continues to develop diagnostic tests called genetic probes or nucleic acid tests ("NAT"). (First Am. Compl. ¶ 6-7). Gen-probe allegedly patented a certain nucleic acid technology known as "Transcription-Mediated Amplification" which enables its products to detect "extraordinarily small quantities of the nucleic acids of infectious agents." (Id. ¶ 9). In early of 1999, Vysis informed Gen-Probe that it believed that Gen-Probe's HIV and HCV blood screening products infringed claims of their United States Patent No. 5,750,338 ("338 patent")

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1 applications would guarantee its resolution within a year and the PTO's procedures concerning the  
2 examination of the application are beyond the Court's control.

3 Consequently, the Court DENIES the request for a stay at this time.

4 **II. Motion to Dismiss the Cause of Action for Unfair Competition**

5 Pursuant to Federal Rule of Civil Procedure 12(b)(6), Vysis also moves to dismiss the fourth  
6 cause of action for unfair competition under California Business and Professions Code section 17200,  
7 *et seq.* To prevail on this claim, Vysis must show that "the plaintiff can prove no set of facts in support  
8 of [its] claim that would entitle [it] to relief." See Schneider v. California Department of Corrections,  
9 151 F.3d 1194, 1996 (9th Cir. 1998). Furthermore, the Court must accept the facts that Gen-Probe  
10 asserts in its complaint as true. See Cooper v. Pickett, 137 F.3d 616, 623 (9th Cir. 1997). Section  
11 17200 proscribes unlawful, unfair or fraudulent business practices or conduct. See Cel-Tech  
12 Communications, Inc. v. Los Angeles Cellular Telephone Co., 20 Cal.4th 163, 180 (1999).

13 Gen-Probe alleges that Vysis "knows or should know the underlying facts establishing the  
14 validity of the . . . '338 patent." (First Am. Compl. ¶ 35). Gen-Probe also alleges that Vysis continues  
15 to attempt to enforce this patent despite its knowledge that the patent is invalid. (*Id.*). The Court finds  
16 that these allegations sufficiently allege a cause of action under Federal Rule of Civil Procedure  
17 12(b)(6). Consequently, the motion to dismiss is DENIED.

18 **CONCLUSION**

19 The Court DENIES the motion for a stay. The Court also DENIES the motion to dismiss the  
20 fourth cause of action.

21 **IT IS SO ORDERED.**

22 DATED: 4/28/00

23 Marilyn L. Huff  
24 MARILYN L. HUFF, CHIEF JUDGE  
25 UNITED STATES DISTRICT COURT  
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The Collins patent is directed to an amplification process for amplifying a target polynucleotide contained in a sample, comprising the steps of contacting the sample with a first support which binds to the target polynucleotide; substantially separating the support and bound target polynucleotide from the sample; and amplifying the target polynucleotide. The term "amplify" is defined very broadly in the specification. This definition is broad enough to include, for example, amplification of captured polynucleotides by cloning; production of cell-free translation products of the captured polynucleotides; and the enzymatic reproduction of the captured polynucleotide.

